

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCE

Ex parte: ROBERT D. HORNING

Application 10/673,453

MAILED

OCT 25 2006

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received at the Board of Patent Appeals and Interferences (BPAI) on October 2, 2006. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below.

April 20, 2006, appellants filed an Appeal Brief. A review of the file reveals that the “Summary of Claimed Subject Matter” does not map the independent claims to the specification, as set forth in 37 CFR § 41.37(c)(1)(v) which states:

(v) *Summary of claimed subject matter.* A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

Proper correction of the Appeal Brief is required.

In addition, an Examiner’s Answer was mailed on July 6, 2006, which stated on page 2 that “the status of claims contained in the brief¹ is correct.” However, the grounds of rejection are listed as follows:

¹ Status of Claims in the Brief page 3 states “[c]laims 16-21 are withdrawn. Claims 1-15 and 22-26 stand rejected. The rejection of claims 1-15 and 22-26 is being appealed.”

(a) Claim 1-15, 23 and 24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Horning et al. and Ohnstein.

(b) Claims 24-26 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Horning and Ohnstein in further view of Scheurenbrand.

It should be noted that the Examiner's Answer fails to discuss the rejection of claim 22. Correction is required.

Accordingly, it is ORDERED that the application is return to the Examiner:

- 1) to hold the Appeal Brief filed on April 20, 2006, defective;
- 2) for notification to appellant to file a supplemental Appeal Brief compliance with 37 CFR § 41.37;
- 3) to vacate the Examiner's Answer mailed July 6, 2006, to consider the supplemental Appeal Brief and for a determination regarding the status of claim 22;
- 4) to submit a revised Examiner's Answer in accordance with the new rules effective September 13, 2004; and

5) for such further action as may be appropriate.

BOARD OF PATENT APPEALS
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